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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/126,096	07/30/98	THORSETT	E 002010-137
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HM12/0809

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EXAMINER

RAO, D

ART UNIT

PAPER NUMBER

1611

DATE MAILED:

6  
08/09/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/126,096

Applicant(s)

Thorsett et al.

Examiner

Deepak Rao

Group Art Unit

1611

☒ Responsive to communication(s) filed on Jul 30, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-18 are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-18 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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### DETAILED ACTION

Claims 1-18 are pending in this application.

#### *Election/Restriction*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-5 and 9-18, drawn to compounds of formula I wherein R<sup>1</sup> and R<sup>2</sup> or R<sup>3</sup> and R<sup>4</sup> together do not form a ring, corresponding composition and method of use, classified in class 562, subclass various.
- II. Claims 1-2 and 8-18, drawn to compounds of formula I wherein R<sup>1</sup> and R<sup>2</sup> together form a ring, corresponding composition and method of use, classified in class 540/544, subclass various.
- III. Claims 1-2, 6-7 and 11-18, drawn to compounds of formula I wherein R<sup>2</sup> and R<sup>3</sup> together form a ring, corresponding composition and method of use, classified in class 546, subclass various.

The inventions are distinct, each from the other because of the following reasons:

The compounds of Groups I-III are drawn to structurally dissimilar compounds. They are made independently and used independently. They would be expected to raise different issues of patentability if a compound of Group I was anticipated, the anticipatory reference would not necessarily render obvious the other groups II-III or vice-versa. They are not art recognized equivalents, they are classified diversely from classes 540, 544, 546, 562/various subclasses and require separate literature searches.

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Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter and their separate classification, restriction for examination purposes as indicated is proper.

In addition to election of a single Group of invention, applicants are further required to elect a single species that belongs to the elected Group.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

A telephone call was made to Mr. Jeffrey Hagenah on August 4, 1999 to request an oral election to the above restriction requirement, but did not result in an election being made. Mr. Hagenah requested the restriction be set forth in writing.

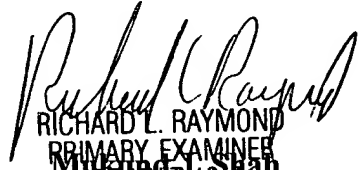
Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).


Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any

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amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Rao whose telephone number is (703) 305-1879. The fax phone number for this Group is (703) 308-4556. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-1235.

  
RICHARD L. RAYMOND  
PRIMARY EXAMINER  
MILKUND J. SHAN  
Supervisory Patent Examiner  
Art Unit 1611

Deepak Rao   
August 5, 1999